

**REMARKS/ARGUMENTS**

Claims 1-3 and 5-28 remain in this application. Applicants respectfully request entry of the above claim amendments and submit that these amendments do not comprise new matter. Basis in the specification for these amendments may be found, in at least one example, on page 12, lines 7-11

**Rejections under 35 U.S.C. § 112**

Applicants note, with appreciation, that the Examiner has withdrawn the rejections of claims 1-4 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

**Rejections under 35 U.S.C. § 102**

Applicants note, with appreciation, that the Examiner has withdrawn the rejection of claim 13 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 5,920,847, issued to Kolling et al. ("Kolling et al.").

**Rejections under 35 U.S.C. § 103**

The Office Action, at paragraph 15, states that, "Applicants' lack of arguments against the language of the rejection of claim 4 implies that he knows that this is an old and well known feature." Applicants respectfully disagree. In the last amendment submitted by Applicants, claim 4 was canceled. As such, any discussion of claim 4 was rendered moot and a lack of arguments against the rejection of claim 4 carries no implication that the prior rejection was in any way proper.

The Office Action, again at paragraph 15, states that, "applicants' lack of arguments against the language of the rejection of claims 1-3 and 5-25 implies that he knows that the identified prior art discloses his invention." Applicants respectfully disagree. In the last

amendment submitted by Applicants, a new element was amended into independent claims 1, 5, 13, 17, and 21—and, thereby, into the claims dependent therefrom. As stated in the remarks accompanying this amendment, Applicants believed this amendment to place the claims in a condition for allowance and, thus, obviate any pending rejections and the need for any further discussion regarding same. Applicants did not intend—nor did they cause—any implication that the rejections of claims 1-3 and 5-25 were in any way proper.

Upon entrance of the above claim amendments, the independent claims of the present invention have been amended to recite a further element of the invention. This element is that the “plurality of clubs, merchants or service providers are affiliated with at least one common partner.” The utilization of a common partner is well disclosed throughout the specification. Applicants respectfully submit that this element of “at least one common partner” would not have been obvious to one of skill in the art at the time of filing of this patent application.

As described in the specification:

Partners may be entities that are associated with a number of clubs, such as a university or military branch. A partner may provide data to a card provider of a number of clubs so that applicants (e.g., students or alumni or service members) can easily join up and set up auto-charge arrangements therewith. By “partnering” with the card provider, both the partner and the card provider derive benefits of bringing the plurality of clubs into the system.

Page 8, lines 6-11.

Further advantages and benefits of partners are also disclosed in the specification:

Partner may be a military branch that is associated with a series of clubs such as garden club, officer’s club, health club and clubs, merchants or service providers. More generally, a partner may comprise a business concern, group or association that itself is associated with a series of clubs or the like. For example, a partner may be a university or military branch that wishes to have data of its various clubs and the like entered onto the system so that students, alumni, or military personnel can readily join clubs and set up auto-charge payment arrangements. The benefits from such an arrangement to the card provider, partner and clubs are substantial.

. . . [I]t can be appreciated that the benefits and efficiencies may be maximized when the card provider has an arrangement with an intermediate partner associated with a number of constituent clubs.

Page 13, line 20 to page 14, line 10.

The invention as now recited in the independent claims comprising a common partner is not taught or disclosed by any of the cited references. Further, the cited references do not disclose any teaching that would have lead one of skill in the art to reach the advantages and benefits conferred by the present invention comprising a common partner. Applicants respectfully submit that the independent claims (and the corresponding dependent claims) are both novel and nonobvious, as nothing in the cited references would lead one to reach the present invention.

### *Claims 1-3*

The Office Action states that claims 1-3 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,787,404, issued to Fernandez-Holmann (“Fernandez-Holmann”); and further in view of Kolling et al.; U.S. Patent No. 6,041,315, issued to Pollin (“Pollin”); U.S. Patent No. 5,326,959, issued to Perazza (“Perazza”); and Official Notice.

Upon entry of the claim amendments, claim 1 has been amended to recite that the “plurality of clubs, merchants or service providers are affiliated with at least one common partner.” This element is not disclosed or taught by any of the cited references. Further, Applicants respectfully submit that this element of “at least one common partner” would not have been obvious to one of skill in the art at the time of filing of this patent application. Even assuming, for the sake of argument, that the cited references may be properly combined, their combination still does not reach all the limitations and elements of claim 1, as amended, or claims 2 and 3—which are dependent upon claim 1.

For at least the foregoing reasons, claims 1-3 distinguish over Fernandez-Holmann, Kolling et al., Pollin, Perazza, or the Official Notice—either by themselves or in combination with each other.

***Claims 5-12***

The Office Action states that claims 5-12 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Fernandez-Holmann; and further in view of U.S. Patent No. 6,014,636, issued to Reeder (“Reeder”); Kolling et al.; and Official Notice.

Upon entry of the claim amendments, claim 5 has been amended to recite that the “plurality of clubs, merchants or service providers are affiliated with at least one common partner.” This element is not disclosed or taught by any of the cited references. Even assuming, for the sake of argument, that the cited references may be properly combined, their combination still does not reach all the limitations and elements of claim 5, as amended, or claims 6-12—which are dependent upon claim 5.

For at least the foregoing reasons, claims 1-3 distinguish over Fernandez-Holmann, Reeder, Kolling et al., or the Official Notice—either by themselves or in combination with each other.

***Claims 13-15***

The Office Action states that claims 13-15 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kolling et al. and Official Notice.

Upon entry of the claim amendments, claim 13 has been amended to recite that the “plurality of clubs, merchants or service providers are affiliated with at least one common partner.” This element is not disclosed or taught by any of the cited references. Even assuming, for the sake of argument, that the cited references may be properly combined, their combination still does not reach all the limitations and elements of claim 13, as amended, or claims 14-15—which are dependent upon claim 13.

For at least the foregoing reasons, claims 13-15 distinguish over Kolling et al. or the Official Notice—either by themselves or in combination with each other.

***Claim 16***

The Office Action states that claim 16 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kolling et al., and further in view of Fernandez-Holmann and Official Notice.

Claim 16 is dependent upon claim 13. As previously discussed, claim 13 has been amended to recite that the “plurality of clubs, merchants or service providers are affiliated with at least one common partner.” This element is not taught or disclosed by either Kolling et al., Fernandez-Holmann or the Official Notice. Even if it were possible to properly combine these references, the combination of these references still does not reach all of the elements and limitations recited in claims 13 and 16.

For at least the foregoing reasons, claim 16 distinguishes over Kolling et al., Fernandez-Holmann or the Official Notice—either by themselves or in combination.

***Claims 17-20***

The Office Action states that claims 17-20 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Fernandez-Holmann, and further in view of Pollin, Kolling et al., and Official Notice.

Claim 17 has been amended to recite that the “plurality of clubs, merchants or service providers are associated with at least one common partner.” This new element is not disclosed or taught by any of the cited references. As such, Applicants respectfully submit that, even if these references could be combined, their combination still does not meet the claims.

For at least the foregoing reasons, claims 17-20 distinguish over Fernandez-Holmann, Pollin, Kolling et al., and the Official Notice—either by themselves or in combination.

***Claims 21-25***

The Office Action states that claims 21-25 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kolling et al., and further in view of Fernandez-Holmann, Pollin, Perazza, and Official Notice.

Claim 21 has been amended to recite that the “plurality of clubs, merchants or service providers are associated with at least one common partner.” This element is not taught or disclosed by any of the cited references and would not have been obvious to one of skill in the art. Accordingly, Applicants respectfully submit that, even if these references could be combined, their combination still does not meet the claims.

For at least the foregoing reasons, claims 21-25 distinguish over Kolling et al., Fernandez-Holmann, Pollin, Perazza, and the Official Notice—either by themselves or in combination.

**CONCLUSION**

Applicants respectfully request entrance of the above claim amendments. In view of the above amendments and remarks, early notification of a favorable consideration is respectfully requested. Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below to conduct an interview in an effort to expedite prosecution in connection with the present application. The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 50-0206.

Respectfully submitted,

Dated: \_\_\_\_\_

Oct. 22, 2003

By: \_\_\_\_\_

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